IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No.: 7448
Sidney *et al.*	Art Unit: 1643
Appl. No.: 10/530,061	Examiner: Bristol, Lynn Anne
§ 371 Date: April 4, 2005	Atty. Docket: 2473.0330002/EKS/M-M
For: **HLA Binding Peptides and Their Uses**	

Reply to Restriction Requirement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated August 23, 2006, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of **Group I**, represented by claims 1, 3-15 and 18. Applicants further provisionally elect the species 9) **papilloma virus**. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. Applicants also elect the following ten (10) peptides as required by the Examiner:

DSVYGDTLER;
HTMLCMCCR;
LYNLLIRCF;
SVYGETLER;
LTEYVLDLY;
TFCCKCDSTF;
AVCDKCLKFR;
ITDIILECVY;
LTDIEITCVY; and
VYCKTVLEF.

These elections are made **with** traverse.

Applicants traverse the restriction requirement, as it applies to Groups 1 and 2, and Groups 3-6. Applicants point out that M.P.E.P. § 803 (8th Ed., Rev. 5, August 2006) lists the criteria for a proper restriction requirement:

> Under the statute, the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 802.01, § 806.06, and § 808.01) or distinct (MPEP § 806.05 – § 806.05(j)).
>
> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Id.

Thus, even assuming, *arguendo*, that Groups 1 and 2 represent distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of all groups would entail a "serious burden." *See* M.P.E.P. § 803 (8th Ed., Rev. 5, August 2006).

Applicants submit that a search of the elected group of peptides would clearly provide useful information for nucleic acids encoding such peptides. For example, the search for publications which disclose any of the elected peptides (Group I) would lead the Examiner to references which disclose the nucleic acids that encode such peptides (Group II).

Applicants also submit that a search related to a method of treating a disease therapeutically would provide useful information for a method of preventing a disease prophylactically. For example, a search for publications which disclose a method of treating a disease using a composition comprising the elected peptide(s) (Group 5 and 6)

would lead the Examiner to references which disclose a method of preventing a disease using a composition comprising the elected peptide(s) (Groups 3 and 4).

In addition, Applications submit that a search related to a method of treating or preventing one disease using a composition comprising the elected peptides would provide useful information for a method of treating or preventing another disease using a composition comprising the elected peptides. For example, a search for publications which disclose treatment or prevention using a composition comprising the elected peptides, would lead the Examiner to references which disclose a method of treating or preventing different types of diseases, such as viral infections (Groups 3 and 5) or cancer (Groups 4 and 6).

In view of the above, Applicants submit that it would not be a serious burden to examine all the claims of Groups 1 and 2 or Groups 3-6 together.

The Examiner has indicated that Group 1 and Groups 3-6 are related as product and process of use. (Office Action, Page 7.) If the Examiner maintains the restriction requirement between Groups 1 and 3-6, Applicants note that in light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996), and the Official Gazette Notice 1184 OG 86 (March 26, 1996), the Examiner is required to rejoin claims 16, 17 and 19 (Groups 3-6) with claims 1, 3-15 and 18 (Group 1) if the claims of Group 1 are found to be allowable. Specifically, the OG Notice states that:

> in the case of an elected product claim, *rejoinder will be permitted when a product claim is found allowable* and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

1184 OG 86 (March 26, 1996) (emphasis added). Accordingly, if the claims of elected Group 1 are found to be allowable, Applicants respectfully request that the claims of Groups 3-6 be rejoined and examined for patentability for the reasons discussed above.

Applicants respectfully request that the present restriction requirement be withdrawn upon consideration of the above arguments and in view of M.P.E.P. § 803.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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